

RemarksStatus of the Claims

Claims 1-39 are pending in the application. All claims stand rejected. By this paper, claims 1 and 2 have been amended, and claims 38 and 39 have been canceled.

Claims 1-5, 7-15, 18-32, and 34-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al. ("LaJoie") in view of Zustak et al. ("Zustak"). Claims 38 and 39 were rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie in view of Zustak, Macrae et al. ("Macrae"), and Jerding et al. ("Jerding"). Claims 6 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie and Zustak in view of Jerding. Claim 33 was rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie and Zustak in view of Klosterman et al. ("Klosterman"). Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie and Zustak in view of Knudson et al. ("Knudson").

LaJoie

The claimed invention relates to delivering interactive content via "synthetic channels," which mimic television channels within an Electronic Program Guide (EPG). While LaJoie arguably shows a channel table (101) including a channel "16" that can be mapped to "other services," there is absolutely no teaching or suggestion of displaying an indication of the other services as synthetic channels within an EPG. Indeed, LaJoie's EPG, as shown, for example, in FIGs. 16 and 17, only depicts regular television channels broadcasting traditional television programs. LaJoie's

channel table is merely a data structure that is represented in memory. There is no indication that it is ever displayed on a user's screen, let alone in an EPG.

The Office Action apparently agreed with this reasoning, stating that "LaJoie is silent on communicating the interactive content elements via an electronic program guide (EPG) and providing selection of the content elements via an EPG." Office Action at page 3. However, the Office Action goes on to cite Zustak for this conspicuously missing element.

Zustak

Declarations under 37 C.F.R. § 1.131 were filed in connection with the Applicants' previous response to remove Zustak as a reference. As detailed in the previous response, Zustak was filed on April 20, 2001, less than two months before the filing date of the present application. In the Declarations of James A. Billmaier, Anthony F. Istvan, and Robert E. Novak, the inventors declared that they conceived of the claimed invention prior to April 20, 2001. In support of the Declarations, a copy of an e-mail dated prior to April 20, 2001 ("Invention Disclosure"), listing the aforementioned individuals as inventors in Digeo internal matter no. 39 (the present application), was attached to the response.

Because all of the rejections rely on Zustak for the claimed limitation of "communicating the interactive programming content, including the interactive content element and the corresponding synthetic channel, to a viewer via an electronic programming guide," as variously recited in independent claims 1, 11, 22,

28, 35 and 38, the Applicants argued that the removal of Zustak as a reference made these claims allowable.

Alleged Deficiencies of the Rule 131 Declarations

1. Evidence of Conception

Paragraph 3 of the Final Office Action alleges that the Invention Disclosure relied upon by the Applicants to swear behind the reference was no more than "a vague idea of how to solve a problem." Specifically, the Final Office Action stated that "there is no evidence conveying providing selection from the electronic program guide *via a user-actuateable device*," as recited in claim 1. (Emphasis added).

The Applicants respectfully submit that the Office's argument fails for at least three reasons. First, even assuming the Office is correct about claim 1, none of the other independent claims recite "selection from the electronic program guide *via a user-actuateable device*." Thus, even if claim 1 was not supported by the Invention Disclosure (which the Applicants vigorously deny), the Applicants believe that claim 11, for example, which does not refer to a "user-actuateable device," is unquestionably supported by the Invention Disclosure.

Second, the Applicants submit the statement that "there is no evidence conveying providing selection from the electronic program guide via a user-actuateable device" is manifestly incorrect. The Invention Disclosure clearly states that the user may access the synthetic channels "by directly entering a channel number in their remote control." (Emphasis added). The Applicants respectfully submit that a person of ordinary skill in the art ("POOSITA") at the time the invention

was made would understand a "remote control" to be a type of "user-actuateable device."

Third, the Applicants respectfully submit that "placing [the synthetic channels] in the EPG and allowing users to access them" would be understood by a POOSITA to be accomplished via a "use-actuateable device," such as a remote control, even without the explicit teaching discussed above. The invention is not directed to a particular means for selecting a synthetic channel from an EPG. EPGs are routinely accessed via remote control devices. What is believed to be novel and non-obvious (as taught by the Invention Disclosure) is providing access to other applications or information (e.g., email, calendar, photo albums, news, weather, sports, etc.) using "synthetic channels" in the EPG. The synthetic channels mimic regular broadcast channels in the EPG but represent content other than traditional broadcast content.

Finally, notwithstanding the foregoing, to advance prosecution of this application, the Applicants have canceled the allegedly unsupported language from claim 1: As amended, claim 1 now reads "providing for selection of the synthetic channel corresponding to the interactive content element from the electronic programming guide to access the interactive content element." This limitation is clearly taught by the Invention Disclosure, as shown in greater detail below.

As demonstrated in the following tables, the limitations of each of the independent claims are described in the Invention Disclosure.

a. Claim 1

Claim Language	Support in Invention Disclosure
A method of accessing interactive content as part of an interactive television system, the method comprising:	"...adding interactive content to television experience." "The functional [synthetic] channels provide access to applications that run on behalf of the user (email, calendar, photo albums, etc.)."
assigning a synthetic channel to correspond to at least one interactive content element available as interactive programming content via the interactive television system;	"The existing programming content is referred to as broadcast channels, while the new interactive content is referred to as synthetic channels." "In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control."
communicating the interactive programming content, including the interactive content element and the corresponding synthetic channel, to a viewer via an electronic programming guide; and	"This can include placing [the synthetic channels] in the EPG or allowing the user to access them by directly entering a channel number in the remote control."
providing for selection of the synthetic channel corresponding to the interactive content element from the electronic programming guide to access the interactive content element.	"In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner." "This can include placing [the synthetic channels] in the EPG or allowing the user to access them by directly entering a channel number in the remote control."

b. Claim 11

Claim Language	Support in Invention Disclosure
A method of accessing interactive content as part of an interactive television viewing environment, the method comprising:	"...adding interactive content to television experience." "The functional [synthetic] channels provide access to applications that run on behalf of the user (email, calendar, photo albums, etc.)."

<p>Displaying an electronic programming guide including accessible broadcast channels and accessible synthetic channels on a video display device for the interactive television viewing environment;</p>	<p>"The existing programming content is referred to as broadcast channels, while the new interactive content is referred to as synthetic channels." "In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control."</p>
<p>correlating the selected synthetic channel to an interactive content element available by way of the interactive television viewing environment;</p>	<p>"The functional [synthetic] channels provide access to applications that run on behalf of the user (email, calendar, photo albums, etc.)." —"In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control."</p>
<p>displaying the interactive content element on the video display device for the interactive television viewing environment.</p>	<p>"In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner." "This can include placing [the synthetic channels] in the EPG or allowing the user to access them by directly entering a channel number in the remote control."</p>

c. Claim 22

Claim Language	Support in Invention Disclosure
An interactive television network environment, comprising:	"The existing typical television environment consists of a television with a connection to a broadcast network that consists of many television channels." "...extend the metaphor when adding interactive content to television experience."
a television set;	"The existing typical television environment consists of a television with a connection to a broadcast network that consists of many television channels."

a client terminal having a network interface configured to transmit and receive encoded communication signals, the client terminal being capable of being connected to the television set; and	"The existing typical television environment consists of a television with a connection to a broadcast network that consists of many television channels." A POOSITA understands that televisions are connected to broadcast networks via network interfaces, e.g., set-top boxes (STBs). That such STBs receive encoded communications signals is known in the art.
a broadcast center, the broadcast center capable of communication with the client terminal; and	"The existing typical television environment consists of a television with a connection to a broadcast network that consists of many television channels." Broadcast networks are known to include broadcast centers from which television broadcasts originate.
wherein the broadcast center is configured to transmit an electronic programming guide to the client terminal, the electronic programming guide including:	"In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control." Electronic program guides are known to be transmitted by and received from broadcast centers.
a listing of channels, the channels comprising cable channels and synthetic channels; and	"The existing programming content is referred to as broadcast channels, while the new interactive content is referred to as synthetic channels." "In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control." Cable channels are known to be a form of broadcast channel.
identification of programming content corresponding to each channel; and	"The existing programming content is referred to as broadcast channels, while the new interactive content is referred to as synthetic channels."

<p>...wherein the client terminal is further configured:</p> <p>to receive a command from a viewer to select a channel from the electronic programming guide, wherein the selected channel comprises a synthetic channel;</p> <p>to transmit an uplink signal to the broadcast center requesting the programming content corresponding to the selected synthetic channel;</p> <p>to receive a downlink signal from the broadcast center, the downlink signal comprising the programming content; and</p> <p>to transmit the programming content to the television set for display.</p>	<p>"This can include placing [the synthetic channels] in the EPG or allowing the user to access them by directly entering a channel number in the remote control." These limitations recite known interactions between a broadcast center and a network interface (STB), e.g., sending uplink signals, receiving downlink signals, etc.</p>
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d. Claim 28

Claim Language	Support in Invention Disclosure
An electronic programming guide, comprising:	"In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control."
a channel field, the channel field including a listing of available cable channels and available synthetic channels; and	"The existing programming content is referred to as broadcast channels, while the new interactive content is referred to as synthetic channels." Electronic program guides with "existing programming content" inherently require a channel "field."
a content field, the content field including a current programming schedule corresponding to each available cable channel, and an interactive content element corresponding to each available synthetic channel.	"In order to mimic the behavior of traditional broadcast channels, access to the synthetic channels should be granted in a similar manner. This can include placing them in the EPG or allowing the user to access them by directly entering a channel number in the remote control." In order to "place [synthetic channels] in

	an EPG, it would be necessary to indicate what interactive content corresponds to each synthetic channel. Otherwise, the user would not know which synthetic channel to select.
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d. Claim 35

Claim 35 includes limitations derived from claims 22 and 28. The principal difference is the format of the claim (*Beauregard*). Since the Invention Disclosure discloses "applications that run on behalf of the user (email, calendar, photo albums, etc.," the Applicants respectfully submit that a POOSITA would understand that such applications run on a computer and that a computer inherently has a "computer-readable medium containing a set of instructions" to carry out the recited functions.

As demonstrated above, all pending independent claims are fully supported by the Invention Disclosure, which has a date prior to the filing date of Zustak. Accordingly, the Applicants respectfully submit that the Invention Disclosure, which is clearly more than a "vague idea," establishes an earlier date of conception.

2. Evidence of Diligence

The Advisory Action mailed June 6, 2006, indicated that additional evidence of diligence "on the part of the attorney" was necessary. The applicants wish to thank the Examiner for the courtesy of the interview on July 5, 2006, wherein the Examiner clarified that the period of time for which diligence needs to be shown runs from just prior to the date of Zustak (*i.e.*, April 20, 2001) to the date of constructive reduction to practice (*i.e.*, June 8, 2001).

Enclosed herewith as Exhibit 1 are the time records of Dennis M. de Guzman, the attorney at Blakely Sokolov Taylor and Zafman responsible for preparation of the above-identified application. Mr. de Guzman supervised Lance Termes, a junior attorney at Blakely Sokolov Taylor and Zafman, in the actual drafting. As shown in the records, Messrs. de Guzman and Termes exercised reasonable diligence in preparing the application during the critical period. A timeline is provided below.

Date	Activity
Thursday, April 12, 2001	Mr. Termes conducts invention disclosure with Anthony Istvan, an inventor in the above-identified application
Friday, April 20, 2001	Date of Zustak reference
Monday, April 23, 2001	Mr. Termes begins work on application
Tuesday, April 24, 2001	Mr. Termes continues to prepare application
Wednesday, April 25, 2001	Mr. Termes continues to prepare application
Monday, April 30, 2001	Mr. Termes continues to prepare application
Tuesday, May 1, 2001	Mr. Termes continues to prepare application
Wednesday, May 2, 2001	Mr. Termes continues to prepare application
May 2, 2001 - May 6, 2001	Mr. Termes provides draft of application to Mr. de Guzman for review
Sunday, May 6, 2001	Mr. de Guzman reviews draft of application
Tuesday, May 8, 2001	Mr. Termes continues work on application; Mr. Termes sends draft to Digeo in-house counsel
Friday, May 11, 2001	Mr. Termes communicates with draftsperson regarding preparation of formal drawings
Monday, May 14, 2001	Draftsman prepares drawings
May 14 - May 31, 2001	In-house counsel for Digeo reviews application and provides application to inventors for review
Friday, June 1, 2001	Mr. Termes receives feedback from in-house counsel; Mr. Termes revises application and coordinates with draftsperson re preparation of additional formal figures
Monday, June 4, 2001	Mr. Termes receives feedback from Robert Novak, one of the inventors; Mr. Termes revises application based on those comments
Thursday, June 7, 2001	Mr. Termes receives email from in-house counsel regarding additional changes to application; Mr. Termes revises the application accordingly
Friday, June 8, 2001	Date of constructive reduction to practice

As indicated by the timeline, the only significant period (more than a few days) during which Messrs. de Guzman and Termes were not actively drafting the application was between May 14 through May 31. During this period, the application was being reviewed by the inventors, as well as Digeo's in-house counsel.

As shown in Exhibit B to the Declaration of Hirohisa Tachibana, the assignee, Digeo, Inc., filed 112 patent applications through outside counsel between August 21, 2000 and June 8, 2001. Given the number of other cases being handled by Digeo's in-house attorney and the fact that the in-house attorney had to coordinate obtaining comments on the draft application from three inventors, the applicants respectfully submit that a two-week period of time to perform these tasks is not unreasonable.

As to the smaller periods for which billing records are not available (e.g., April 27-28, 2001), the applicants respectfully submit that these gaps do not in any way suggest that the applicants intended to "abandon, suppress, or conceal" the invention under 35 U.S.C. § 102(g). MPEP 2138.06 only requires "reasonable diligence." Indeed, Messrs. de Guzman and Termes were attorneys at a busy patent law firm with clients other than Digeo, Inc., as well as prosecution dockets with urgent deadlines. Mr. de Guzman had to perform his supervisory review of the application on a weekend (Sunday, May 6, 2001), which suggests diligence.

The undersigned was unable to obtain complete time records for Messrs. de Guzman and Termes from the law firm of Blakely Sokolov Taylor and Zafman, because they are no longer employed there. However, based on the billing records obtained for the matter in question, it is clear that Messrs. de Guzman and Termes "worked reasonably hard on the application during the continuous critical period."

MPEP 2138.06 citing *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986).

Conclusion

In view of the foregoing, the Applicants respectfully submit that all pending claims herein are in condition for allowance. Early allowance of all pending claims is respectfully requested. If the Examiner finds any remaining impediment to the prompt allowance of all claims, the Applicants respectfully request that the Examiner call the undersigned at the telephone number provided below.

Respectfully submitted,

-----Digeo, Inc.

By



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EXHIBIT 1

Firm: Blakeley Sokoloff Taylor Zafman

Report: ap001bela.R

From: 01/01/00 thru 06/30/06

Selected matter: 005217.P049

Group Entry (Category) Date Description of service, disbursements

48910.66	DS GURMAN	02/26/01	Prepare application
49282.18	TERMES	03/19/01	Review invention disclosure
49282.30	TERMES	03/27/01	Prepare for meeting with Mr. Isayan re. invention disclosure;
49512.25	TERMES	04/09/01	Prepare patent application
49512.30	TERMES	04/16/01	Prepare patent application
49512.39	TERMES	04/12/01	Prepare for and attend meeting with Mr. Isayan regarding patent application disclosure; Prepare patent application
49512.63	TERMES	04/23/01	Prepare patent application
49512.65	TERMES	04/24/01	Prepare patent application
47070.162	Mac Eagen	04/24/01	Cost of obtaining copies of patent
49512.67	ZELMAN	04/25/01	Prepare patent application
49512.72	TERMES	04/30/01	Prepare patent application
49887.1	TERMES	05/01/01	Prepare patent application
49887.6	TERMES	05/02/01	Prepare patent application
49763.19	DE GUZMAN	05/06/01	Review and revise draft prepared by Mr. Termes
49887.18	TERMES	05/08/01	Prepare patent application; Email Mr. Okamoto regarding draft patent application and figures for review.
49887.45	TERMES	05/11/01	Teleconference with, and email to draftsman regarding preparation of formal patent figures
49652.22	Draftsman	05/14/01	Cost of formal patent drawings
50153.1	ZELMAN	05/01/01	Voucher 141226 Vendor: Collid Tech Graphic Design
50153.1	TERMES	05/01/01	Review email from Mr. Okamoto regarding draft patent application; Revise utility patent application and figures; Email Mr. Okamoto regarding revised draft patent application; Email draftsman regarding preparation of additional formal figures.
50153.5	TERMES	05/04/01	Review email from Mr. Okamoto regarding revisions to patent application from Mr. Novak; Revise patent application; email Mr. Okamoto regarding revised draft of patent application
50153.16	TERMES	06/07/01	Review email from Mr. Okamoto regarding finalization of application; Revise patent application
49974.38	Draftsman	05/07/01	Cost of formal patent drawings, 2 sheets

Plm: Blakey Sokoloff Taylor Gafman
 Report: 09001b01a.R
 From: 01/01/00 thru 06/30/06

Selected matter: 005217.P049 TT

Group Entry (category) Date Description of service, disbursements

50153.17	TERMS	06/06/01	Vendor, Calli Tech Graphic Design Revise patent application; Prepare filing documents; Correspondence with USPTO regarding filing utility patent application; unsigned declaration, and non-publication request; email Mr. Okamoto regarding electronic copy of filed patent application; correspondence with Ms. Gladden regarding filed patent application and filing documents.
50153.22	TERMS	06/23/01	Small Mr. Okamoto regarding formal patent figures
50889.36	TERMS	08/27/01	Preparation of Information Disclosure Statement
50889.49	TERMS	08/29/01	Correspondence with U.S. Patent and Trademark Office regarding filing of Information Disclosure Statement, response to Missing Parts, and Assignment
50746.20	PERVILE	08/30/01	U.S. Patent and Trademark Office Assignment Recordation filing fee
50746.21	PERVILE	08/30/01	U.S. Patent and Trademark Office patent application filing fee and extra claims and Missing Parts filing fee
51218.48	DB GUTZMAN	11/20/01	File request to rescind nonpublication request

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